

REMARKS

This responds to the Office Action mailed on December 18, 2008.

Claims 1-3, 8-10, 15-17, and 21-24 are amended, claims 7, 14, 21, and 28 are canceled, and no claims are added; as a result, claims 1-6, 8-13, 15-20, and 22-27 are now pending in this application.

Specification objections

The specification was objected to because of informalities.

The Abstract of the discloser and paragraphs [0008], [00111], and [00112] of the specification have been amended to address the objections. Accordingly, it is requested that the objections be reconsidered and withdrawn.

Claim objections

Claims 1-28 were objected to because of informalities.

In response to the objections, claims 1-3, 8-10, 15-17, and 22-24 have been amended to replace the phrase “fixed-price” with “fixed price” to address the objections. Therefore, Applicants respectfully request that the claim objections be reconsidered and withdrawn.

§ 101 Rejection of the Claims

Claims 8-15 and 22-28 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

The Office Action asserts that means of claim 8 can plausibly be interpreted as pure software. Applicants have amended independent claim 8 to recite “*a processing means coupled to a memory through a bus*” and “*the program means to be executed from the memory by the processing means*.¹” The *memory* and the *processing means* as recited in the independent claim 8 are hardware, because the *processing means* is capable of executing the program means from the memory. As such, amended independent claim 8 and its dependent claims 9-13 and 15 are clearly directed to statutory subject matter. Claim 14 has been canceled.

Independent claim the independent claim 22 was rejected as not being conforming to Bilski.¹ Independent claim 22 has been amended to address the rejection. Independent claim 22,

¹ In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v.

as amended, now recites in pertinent part, “*facilitating the operation of a network-based auction price-setting process for a listing of an item using a fixed price-setting process executed from a memory by a processor.*” Accordingly, independent claim 22 is tied to hardware (i.e., memory and processor) and clearly conforms to the requirements set forth in Bilski. Therefore, independent claim 22 and its dependent claims 23-27 are directed to statutory subject matter. Claim 28 has been canceled.

Applicants respectfully request that the claim rejections under 35 U.S.C. §101 be reconsidered, in view of the amendments, and withdrawn.

§ 102 Rejection of the Claims

Claims 8 and 22 were rejected under 35 U.S.C. § 102(e) as being anticipated by Popovitch (U.S. Publication No. 2004/0024682).

Applicants respectfully submit that, in light of the amendments, a *prima facie* case of anticipation cannot be established because Popovitch does not disclose each and every limitation of the independent claims 8 and 22 of the present application.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.²

Applicants have amended independent claims 8 and 22 to incorporate an allowable limitation. The independent claims 8 and 22, as amended, now read in pertinent part, “publishing fixed price offer on the listing, responsive to a bid to buy the item reaching a certain value during the auction.” The Final Office Action at page 12, states “[n]either Popovitch, Churchill, nor other prior arts of record disclose, in conjunction with the limitations of claim 1, publication of a fixed offer responsive to a bid to buy the item reaching a certain value during the auction.” Accordingly, independent claims 8 and 22 are now allowable.

Therefore, Applicants respectfully request that the claim rejections under 35 U.S.C. § 102(a) be reconsidered, in light of the amendments, and withdrawn.

Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780, 787-88 (1876)

² *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, USPQ2d 1051, 1053 (Fed. Cir. 1987)

§ 103 Rejection of the Claims

Claims 1-7 were rejected under 35 U.S.C. § 103(a) as being obvious over Popovitch in view of Churchill et al. (U.S. Patent No. 7,461,022, hereinafter; "Churchill").

Claims 9-11 and 13-14 were rejected under 35 U.S.C. § 103(a) as being obvious over Popovitch as applied to claim 8 above, and further in view of Churchill.

Claim 12 was rejected under 35 U.S.C. § 103(a) as being obvious over Popovitch and Churchill as applied to claim 11 above, and further in view of the Official Notice.

Claims 15-18 and 20-21 were rejected under 35 U.S.C. § 103(a) as being obvious over Popovitch in view of Churchill.

Claim 19 was rejected under 35 U.S.C. § 103(a) as being obvious over Popovitch and Churchill as applied to claim 18 above, and further in view of the Official Notice.

Claims 23-25 and 27-28 were rejected under 35 U.S.C. § 103(a) as being obvious over Popovitch as applied to claim 22 above, and further in view of Churchill.

Claim 26 was rejected under 35 U.S.C. § 103(a) as being obvious over Popovitch and Churchill as applied to claim 25 above, and further in view of the Official Notice.

Applicants have amended independent claims 1 and 15 to incorporate the allowable limitation. The independent claims 1 as amended, now read in pertinent part, "to publish fixed price offer on the listing, responsive a bid to buy the item reaching a certain value during the auction." The amended independent claim 15 includes substantially the same limitation. The Final Office Action at page 12, states "[n]either Popovitch, Churchill, nor other prior arts of record disclose, in conjunction with the limitations of claim 1, publication of a fixed offer responsive to a bid to buy the item reaching a certain value during the auction." Accordingly, independent claims 1 and 15 and their dependent claims 2-6, 16-20 are now patentable.

Dependent claims 9-13 and 23-27 are respectively dependent on independent claims 8 and 22 and are deemed to include all of the claim elements of the claims, which they are dependent on. Accordingly, these claims are also patentable.

Applicants respectfully request that the claim rejections under 35 U.S.C. § 103(a) be reconsidered, in light of the amendments, and withdrawn.

Allowable Subject Matter

Claims 7, 14, 21 and 28 were objected to as being dependent upon a rejected base claim, but were indicated to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, and also rewritten to define their potentially patentable elements more narrowly, and, in the cases of claims 14 and 28, rewritten to make them statutory under 35 U.S.C. § 101.

Applicants thank the Examiner for allowing 7, 14, 21 and 28. These claims have been canceled and their respective limitations have been incorporated into independent claims of the application that are now asserted be allowable.

AMENDMENT AND RESPONSE UNDER 37 C.F.R § 1.111

Serial Number: 10/749,628

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Title: INTRODUCING A FIXED-PRICE TRANSACTION MECHANISM IN CONJUNCTION WITH AN AUCTION TRANSACTION MECHANISM

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CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone the undersigned at (408) 278-4046 to facilitate prosecution of this application.

If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on March 18, 2009.

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